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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of : Confirmation No. 2874  
Keiji KAMIYAMA et al. : Docket No. 2001\_0710A  
Serial No. 09/857,887 : Group Art Unit 1654  
Filed June 13, 2001 : Examiner Michael V. Meller

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AND USE

ALL INFORMATION UNDER 37. CFR 1.11  
EXPEDITED PROSECUTION  
EXAMINING GROUP 1654

**REQUEST FOR RECONSIDERATION AFTER FINAL**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

This is responsive to the final Official Action dated November 19, 2003.

The Action states that claims 1-11 are allowed and that claims 12-23 are withdrawn from consideration. The Action states that claims 12-23 are still subject to restriction and should be cancelled.

The Applicant acknowledges with thanks the Examiner's indication of allowance of claims 1-11. However the Applicant respectfully requests reconsideration of the restriction requirement.

Claims 12-16 are directed to a pharmaceutical composition which requires as a mandatory component the compound according to claim 1. The composition and compound claims thus have the relationship of combination and subcombination claims, respectively. The compound of allowed claim 1 is essential to the composition claims. The essential distinguishing patentable feature of the composition claims is the claimed compound .

MPEP 806.05 provides in pertinent part:

## “II. SUBCOMBINATION ESSENTIAL TO COMBINATION

ABsp/Bsp No restriction

If there is no evidence that combination ABsp is patentable without the details of Bsp, restriction should not be required. Where the relationship between the claims is such that the separately claimed subcombination Bsp constitutes the essential distinguishing feature of the combination ABsp as claimed, the inventions are not distinct and **a requirement for restriction must not be made**, even though the subcombination has separate utility.” (emphasis added)

Accordingly, it is respectfully submitted that the restriction requirement with respect to claims 12-16 is in error and should be withdrawn.

Claims 17-23 are method claims which require as a mandatory element use of the compound of claim 1. Rejoinder of these claims is proper under PTO rules.

MPEP 821.04 provides in pertinent part:


“Where product and process claims drawn to independent and distinct inventions are presented in the same application, applicant may be called upon under 35 USC 121 to elect claims to either the product or process. See MPEP 806.05(f) and 806.05(h). The claims to the nonelected invention will be withdrawn from further consideration under 37 CFR 1.142. See MPEP 809.02(c) and 821 through 821.03. However, if Applicant elects claims directed to the product, and a product claim is subsequently found allowable; withdrawn process claims which depend from or otherwise include all the limitations of the allowable product claim **will be rejoined**.” (emphasis added)

In this case, the Applicant elected to product claims, i.e. the compound of claim 1. The compound of claim 1 has been found allowable. Rejoinder of the non-elected method claims is proper, and not discretionary.

Accordingly, withdrawal of the restriction requirement with respect to claims 12-16, and rejoinder of claims 17-23, is respectfully requested.

Respectfully submitted,

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